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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,612	06/03/2002	Corinne Elizabeth Augelli-Szafran	5944-01-DRK	3747

7590 02/17/2005

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EXAMINER

BERNHARDT, EMILY B

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 02/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/009,612

Applicant(s)

AUGELLI-SZAFRAN ET AL.

Examiner

Emily Bernhardt

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 and 10-24 is/are pending in the application.
- 4a) Of the above claim(s) 10-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 22-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

In view of applicants' response filed 11/19/04 the following still applies.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-3 and 22-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tadao (EP'109) for reasons of record. While claim 1 is no longer anticipated it now contains subject matter that is obvious over Tadao as set forth in the last office action. Applicants' traverse to this rejection is not persuasive for the following reasons. Contrary to what applicants state the motivation to make higher homologs of applicants' invention, namely butylamino derivatives, comes from the express teachings in Tadao. See especially page 3 which includes such compounds as part of the preferred embodiments. Obviousness only requires a reasonable expectation of success not absolute predictability as set forth in *In re O'Farrell* 7 USPQ 2d 1673. The fact that Tadao may not teach cycloalkylamino or naphthyl groups as applicants urge is irrelevant since the thrust of the rejection is the obviousness of C4-alkylamino group(s) which has not been shown to be patentably distinct over the closest compound in Tadao. Thus given the teachings of Tadao to make higher homologs of compound 14, this rejection is being maintained.

Claims 1-6 and 22-24 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Bue-Valesky (US'314) for reasons of record. Applicants were not left to pick and choose from the generic embodiments of the patent but rather 2 species were pointed out for testing against closest instant compounds. In view of applicants' amendments to the claims eg.82 differs in having bis-methylamino groups and H vs instant acetic acid and eg.86 differs only in the nature of substituent on phenyl ring- sulfonamido group vs. instant butylamino group. However, contrary to what applicants urge there is sufficient teaching in the patent to arrive at applicants' compounds given the preferred embodiments include not only bis-methylamino groups but also higher homologs and at the 3-position of the thiazolidinone ring not only H but also acetic acid. See in particular col.10, lines 47 through col.11, line 17 which is directed to preferred compounds for treating Alzheimer's Disease. Thus the motivation to arrive at instant compounds comes from the preferred embodiments of commonly assigned US'314. Furthermore, references are not limited to just their working examples but for all they fairly teach. See *In re Lamberti* 192 USPQ 278; *In re Mills* 176 USPQ 196 regarding the latter point.

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1 and 22 are rejected under 35 U.S.C. 102(a) as being anticipated by Esswein (WO'747). The WO publication cited in applicants' IDS describes a compound within the instant scope namely where R1 and R2 are each n-butyl. See 2<sup>nd</sup> last species on p.27 of the WO document. Said compound is taught for a pharmaceutical use, namely treating bone disorders.

It is recognized that applicants are claiming benefit under 35 USC 119(e) which would antedate WO'747. However the claims rejected herein are not entirely described in earlier provisional case. Note that scope of R1/R2 rings is broader herein than in priority case and there is a proviso excluding certain embodiments at R1/R2 which narrows the genus even further in the US provisional case. Thus only the international filing date is accorded the instant claims and WO'747 is a competent reference. Claim 2 is accorded 119(e) benefit and thus not rejected herein.

Claims 3 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Esswein (WO'747). The teachings of Esswein as discussed in the above 102 rejection are incorporated herein. Closest species in claim 3 to species on p.27 are higher homologs, namely propionic and butyric acid derivatives. However, note that Esswein teaches higher alkanolic acid derivatives. See definition of "a" which is from 0 to 4. Thus it would have been obvious to one skilled in the art at the time

the instant invention was made to modify the acetic acid species in Eswein by lengthening the chain at “(CH<sub>2</sub>)”<sub>a</sub> and in so doing obtain additional compounds for uses taught by the applied art in view of the equivalency teaching outlined above.

The many species in claim 3 (and 23 dependent thereon) are not completely described in earlier US provisional case and thus Esswein is a competent reference against these claims as well.

It is noted that the Examiner's initial do not appear alongside the cite for WO'747 in the IDS and thus is being cited on the 892 form accompanying this action. Also cited is the US equivalent, US'816 which is limited to method claims.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the

advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Emily Bernhardt whose telephone number is 571-272-0664.

If attempts to reach the examiner by telephone are unsuccessful, the acting supervisor for AU 1624, James O. Wilson can be reached at 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.



Emily Bernhardt  
Primary Examiner  
Art Unit 1624